



GRTSTF.011A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Weatherill et al.
Appl. No. : 09/777,420
Filed : February 6, 2001
For : REEL HOUSING WITH
DECORATIVE ACCESS PANEL
Examiner : Nguyen, John Quoc
Group Art Unit : 3654

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Appeal Brief -- Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

September 27, 2004

(Date)

Sanjiv S. Gill
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ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief -- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is filed in response to the Examiner's Answer in this appeal, mailed on July 26, 2004.

I. Examiner Has Not Established *Prima Facie* Case of Obviousness

The Examiner continues to reject Claims 1-23, 25, and 28 under 35 U.S.C. §103(a) as being unpatentable over Hall, U.S. Patent No. 2,403,277. The Examiner also continues to reject Claim 27 under 35 U.S.C. §103(a) as being unpatentable over Hall in view of Ewald, U.S. Patent No. 2,286,904.

Appellants respectfully submit that when a rejection for obviousness depends on a combination of elements disclosed in prior art references, there must be a suggestion or motivation to combine those particular elements in the prior art as a **whole**. Although a prior art device may be capable of being modified to achieve the claimed structure, there must be a suggestion or motivation in the reference for doing so. *In re Mills*, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990). The Examiner's asserted combination fails to provide a *prima facie* case of